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REMARKS

Claims 1, 2, 4-9, and 45-80 are pending in the present application, with claims 59-80 added by the present amendment.

In the office action of March 30, 2007, the following actions were taken:

- (1) Claims 1, 2, 4-9, and 45-58 were rejected under 35 U.S.C. 112, second paragraph; and
- (2) Claims 45, 46, 49-53 and 56-58 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,632,584 (hereinafter "Morgan").

It is respectfully submitted that the presently pending claims be examined and allowed. Applicants submit that each and every amendment herein, and throughout the prosecution of the present application is fully supported by the specification as originally filed, and that no new matter has been added.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claim 1, 2, 4-9, and 45-58 under 35 U.S.C. 112, second paragraph. Specifically, the Examiner has asserted that that (a) absent an underlying substrate or support, the "article" embodiment is indefinite since it is actually a composition; and (b) the "composition" embodiment cannot be overprinted. The Examiner further argues that if one element is overprinted on another element, the resulting product is an article, not a composition. By the present amendment, the two different embodiments are separated out into two types of claims, i.e. article claims and composition claims. This was done to adequately cover all embodiments that were previously elected, and to remove all issues raised by the Examiner. Specifically, the use of "overprinting" is limited to claims directed to articles. As such, the Examiner should no longer take issue with the term being used in claims directed to "composition or article." The Applicant respectfully requests that the Examiner withdraw this rejection, and review all claims as they are currently presented in accordance with the election previously made. It is emphasized that the new claims are not different in scope than that originally presented and elected, as they merely claim one of the embodiments alone to remove the Examiner's concern as to whether a composition or article is appropriately defined as being "overprinted."

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Rejections Under 35 U.S.C. § 103

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing the prior art reference, or references combined, teach or suggest all the claim limitations in the instant application. Further, the Examiner has to establish some motivation or suggestion to combine and/or modify the references, where the motivation must arise from the references themselves, or the knowledge generally available to one of ordinary skill in the art. The Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in any of the rejections.

The Examiner has rejected claims 45, 46, 49-53, and 56-58 as being obvious. Specifically, claims 45, 46, 49-53, and 56-58 were rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan.

The Morgan Reference.

Morgan sets forth a laser-imageable printing system for wet lithographic printing. The composition is modifiable using laser energy, i.e. between hydrophobic and hydrophilic in order to form wet "negatives." A specific chroman is listed amongst many possible components that can act as a reducing agent for silver ions. See col. 8, lines 37-39.

Claims 45-58

Both claims 45 and 52 require chroman function at least as a stabilizer. In claim 45, the chroman stabilizer is configured for both stabilizing the infrared absorber and inhibiting oxidation of the leuco dye. Claim 52 requires the presence of chroman as a stabilizer formulated for stabilizing the infrared absorber, and further requires the presence of another component for providing anti-oxidative properties to the leuco dye.

Regarding independent claims 45 and 52, Morgan does not teach of the presence of a chroman in a composition that is configured or formulated to provide the function of stabilizing the infrared absorber, and in the case of claim 45, inhibiting

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oxidation of the leuco dye. In Morgan, the presence of chroman (among many other possible compound candidates) is used as a reducing agent for silver ions that are present in the disclosed system. If the chroman composition is used as a reducing agent for silver ions (which must be present in Morgan), then it cannot maintain an appropriate state to function as claimed in claim 45 or claim 52.

Even if a compound can function in two distinct manners, it is not inherent that the compound will do so in any given situation. Specifically, the chroman composition in the Morgan reference is acting as a reducing agent, which requires the chroman to undergo an oxidation-reduction (Redox) reaction. Such a use destroys the functionality of chroman for the purposes of the present invention. Morgan clearly teaches that chroman is used specifically as a reducing agent for silver ions. See col. 8, line 37 through col. 9, line 20. Therefore, chroman cannot be used as a stabilizing agent and/or inhibiting the oxidation of the leuco dye as presently claimed as chroman would no longer exist in that form.

The Examiner argues that since no reaction is 100% complete, some unreacted chroman will be present. While this statement may be true, it does not, in any respect, teach a chroman stabilizer formulated or configured for stabilizing an infrared absorber. The chroman in Morgan is used specifically as a reducing agent for silver ions. It naturally follows that chroman is not added with the purpose or desired function, and therefore is not formulated or configured, to stabilize an infrared absorber. Furthermore, while the composition of Morgan may have excess chroman due to incomplete reaction, Morgan does not teach formulating for excess, nor formulating for purposes other than acting as a reducing agent for silver ions, nor would any amount of excess or unused chroman of Morgan necessary function as a stabilizer for an infrared absorber. As such, the chroman of Morgan does not function as a stabilizing agent. Morgan clearly does not teach formulating or configuring a chroman in a composition to stabilize an infrared absorber, as is required by claims 45 and 58.

Thus, claims 45 to 58, along with all dependent and newly-presented claims, are believed to be allowable over Morgan. Reconsideration of the rejections over Morgan is respectfully requested on these grounds.

If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone

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interview, the Examiner is invited to telephone the undersigned attorney, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 2nd day of July, 2007.

Respectfully submitted,



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